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10/685,098	10/14/2003	Nobuhiro Itoh	2271/71239	4451
Ivan S. Kavrukov, Esq. Cooper & Dunham LLP			EXAMINER	
			PACHOL, NICHOLAS C	
New York, N	of the Americas 7 10036		ART UNIT	PAPER NUMBER
			2625	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

Application No.	Applicant(s)	
10/685,098	ITOH, NOBUHIRO	
Examiner	Art Unit	
Nicholas C. Pachol	2625	

THORIOGO C. I GOIGI				
- The MAILING DATE of this communication appears on the cover sheet with the correspondence address - Period for Reply				
A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.  Extension of time may be available under the provisions of 37 CFR 1.35(a). In no event, however, may a neby be timely filed.  If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.  Failure for reply whith the set or extended period for reply with graduel, cause the application to become ARADONED (30 U.S.C. § 133).  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patter from adjustments. See 37 CFR 1.74(b).				
Status				
1)⊠ Responsive to communication(s) filed on 21 August 2008.				
2a)⊠ This action is <b>FINAL</b> . 2b)□ This action is non-final.				
3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is				
closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11, 453 O.G. 213.				
Disposition of Claims				
4) Claim(s) 1-33 is/are pending in the application.				
4a) Of the above claim(s) is/are withdrawn from consideration.				
5) Claim(s) is/are allowed.				
6)⊠ Claim(s) <u>1-33</u> is/are rejected.				
7) Claim(s) is/are objected to.				
8) Claim(s) are subject to restriction and/or election requirement.				
Application Papers				
9)⊠ The specification is objected to by the Examiner.				
10)☐ The drawing(s) filed on is/are: a)☐ accepted or b)☐ objected to by the Examiner.				
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).				
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).				
11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.				
Priority under 35 U.S.C. § 119				
12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f). a) ☐ All b) ☐ Some * c) ☐ None of:				
1. Certified copies of the priority documents have been received.				
<ol><li>Certified copies of the priority documents have been received in Application No</li></ol>				
3. Copies of the certified copies of the priority documents have been received in this National Stage				
application from the International Bureau (PCT Rule 17.2(a)).				
* See the attached detailed Office action for a list of the certified copies not received.				
Attachment(s)				

1) Notice of References Cited (PTO-892) 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (FTO/SE/CE) Paper No(s)/Mail Date \_\_\_\_\_

Interview Summary (PTO-413)
 Paper No(s)/Mail Date.
\_\_\_\_\_.

5) Notice of Informal Patent Application 6) Other: \_\_

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# **DETAILED ACTION**

#### Response to Arguments

 Applicant's arguments with respect to claims 1, 11, 14, and 24 have been considered but are moot in view of the new ground(s) of rejection.

#### Drawings

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the "notifying section configured to output a communication result notification indicative of a result of the facsimile transmission to the receiving end" must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filling date of an application must be labeled in the top margin as either "Replacement Sheet" or "New

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Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

# Specification

The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

# Claim Rejections - 35 USC § 112

- 4. The following is a quotation of the second paragraph of 35 U.S.C. 112:
  The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
- 5. Claims 1, 11, 14, and 24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Although the terms of a claim may appear to be definite, inconsistency with the specification disclosure or prior art teachings may make an otherwise definite claim take on an unreasonable degree of uncertainty. *In re Cohn*, 438 F.2d 989, 169 USPQ 95 (CCPA 1971); *In re Hammack*, 427 F.2d 1378, 166 USPQ 204 (CCPA 1970). In *Cohn*, the claim was directed to a process of treating a surface with a corroding solution until the metallic appearance is supplanted by an "opaque" appearance. Noting that no claim may be read apart from and independent of the supporting disclosure on which it is based, the court found that the description, definitions and examples set forth in the

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specification relating to the appearance of the surface after treatment were inherently inconsistent and rendered the claim indefinite. The limitation of concern is "a notifying section configured to output a communication result notification indicative of a result of the facsimile transmission to the receiving end only when the specific destination identifying section finds the corresponding destination name in the specific destination name storage section." The issue is that the result notification is stated in the claim to be outputted to the receiving end. In paragraph 29, Page 13, line 25 – Page 14, line 12 of the originally filled specification states that the result notification is transmitted to the result report output section. The definition of a result report output section according to paragraph 25, Page 11, lines 24 – Page 12, line 12, of the originally filled specification states the communication result report can be displayed on the display section. This is inconsistent with the claim stating that the result notification is outputted to the receiving end.

### Claim Rejections - 35 USC § 103

- The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:
  - (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.
- Claims 1-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cairo (US 5,809,116) in view of Tanimoto (US 2003/0020960).

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Regarding Claim 1, Cairo teaches a facsimile apparatus (Column 5, lines 33-35) comprising:

a receiving end identifying section configured to identify a receiving end by analyzing terminal information received from the receiving end when making a facsimile transmission to the receiving end (Figure 2, element 30 and Column 5, lines 39-42).

However Cairo does not teach a specific destination name storage section configured to store destination names of specific destinations; and

a specific destination identifying section configured to search from the specific destination name storage section a destination name corresponding to the receiving end to which said facsimile transmission is being made and which is identified by the receiving end identifying section; and

and a notifying section configured to output a communication result notification indicative of a result of the facsimile transmission to the receiving end only when the specific destination identifying section finds the corresponding destination name in the specific destination name storage section,

wherein when the destination name corresponding to the receiving end to which the facsimile transmission is made is found amongst the destination names stored in the specific destination name storage section, said specific destination identifying section cause said notifying section to output said communication result notification.

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Tanimoto does teach a specific destination name storage section configured to store destination names of specific destinations (Page 7, paragraph 89); and

a specific destination identifying section configured to search from the specific destination name storage section a destination name corresponding to the receiving end to which said facsimile transmission is being made and which is identified by the receiving end identifying section (Page 7, paragraph 89);

and a notifying section configured to output a communication result notification indicative of a result of the facsimile transmission to the receiving end only when the specific destination identifying section finds the corresponding destination name in the specific destination name storage section (Page 7, paragraph 89),

wherein when the destination name corresponding to the receiving end to which the facsimile transmission is made is found amongst the destination names stored in the specific destination name storage section, said specific destination identifying section cause said notifying section to output said communication result notification (Page 7, paragraph 89).

Cairo and Tanimoto are combinable because they deal with facsimile transmissions.

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teaching of Cairo with the teaching of Tanimoto for the purpose of providing the user with the ability to select the most appropriate transmission methods and operations (Tanimoto: Page 1, paragraph 11).

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Regarding Claim 2, Cairo further teaches wherein the notifying section outputs a communication result report for each facsimile transmission made to the receiving end having the corresponding destination name stored in the specific destination name storage section (Column 2, lines 49-54).

Regarding Claim 3, Cairo further teaches wherein the communication result report has contents and/or format set differently for each specific destination (Column 2, lines 50-54).

Regarding Claim 4, Cairo further teaches wherein the notifying section displays or prints the communication result report (Column 5, lines 62-67).

Regarding Claim 5, Cairo in view of Tanimoto teaches wherein the notifying section outputs a transmission end sound for each facsimile transmission made to the receiving end having the corresponding destination name stored in the specific destination name storage section (Cairo: Column 8, lines 5-15, wherein since the user selects if they want a notification or not, since the notification could be a sound, they can select if they want the sound or not).

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Regarding Claim 11, Cairo teaches a facsimile apparatus comprising:

receiving end identifying means for identifying a receiving end by analyzing terminal information received from the receiving end when making a facsimile transmission to the receiving end (Figure 2, element 30 and Column 5, lines 39-42); and

notifying means for outputting a communication result notification indicative of a result of the facsimile transmission to the receiving end only when the specific destination identifying means finds the corresponding destination name in the specific destination name storage means (Column 5, lines 49-56 and Column 5, lines 59-66),

wherein when the destination name corresponding to the receiving end to which the facsimile transmission is made is found amongst the destination names stored in the specific destination name storage means, said specific destination identifying means causes said notifying means to output said communication result notification.

However Cairo does not teach a specific destination name storage means for storing destination names of specific destinations; and

specific destination identifying means for searching from the specific destination name storage means a destination name corresponding to the receiving end to which said facsimile transmission is being made and which is identified by the receiving end identifying means; and

notifying means for outputting a communication result notification indicative of a result of the facsimile transmission to the receiving end only when the specific

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destination identifying means finds the corresponding destination name in the specific destination name storage means,

wherein when the destination name corresponding to the receiving end to which the facsimile transmission is made is found amongst the destination names stored in the specific destination name storage means, said specific destination identifying means causes said notifying means to output said communication result notification.

Tanimoto does teach a specific destination name storage means for storing destination names of specific destinations (Page 7, paragraph 89); and

specific destination identifying means for searching from the specific destination name storage means a destination name corresponding to the receiving end to which said facsimile transmission is being made and which is identified by the receiving end identifying means (Page 7, paragraph 89); and

notifying means for outputting a communication result notification indicative of a result of the facsimile transmission to the receiving end only when the specific destination identifying means finds the corresponding destination name in the specific destination name storage means (Page 7, paragraph 89),

wherein when the destination name corresponding to the receiving end to which the facsimile transmission is made is found amongst the destination names stored in the specific destination name storage means, said specific destination identifying means causes said notifying means to output said communication result notification (Page 7, paragraph 89).

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Cairo and Tanimoto are combinable because they deal with facsimile transmissions

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teaching of Cairo with the teaching of Tanimoto for the purpose of providing the user with the ability to select the most appropriate transmission methods and operations (Tanimoto: Page 1, paragraph 11).

Regarding Claim 12, Cairo in view of Tanimoto teaches wherein the notifying means makes the communication report notification by one or an arbitrary combination of communication report notifications selected from a group consisting of outputting a communication result report, outputting a transmission end sound, and printing a stamp mark on a scanned document, for each facsimile transmission made to the receiving end having the corresponding destination name storage means (Cairo: Column 8, lines 5-15, wherein since the user selects if they want a notification or not, since the notification could be a sound, they can select if they want the sound or not. Having the option to choose between a song and a display and none at all makes it inherit to have the choice of a stamp, a sound, or a result report).

Regarding Claim 14, Cairo teaches a facsimile communication method comprising:

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(b) identifying a receiving end by analyzing terminal information received from the receiving end when making a facsimile transmission to the receiving end (Figure 1); and

(d) outputting a communication result notification indicative of a result of the facsimile transmission to the receiving end only when the corresponding destination name is found in the storage section (Figure 1 and Figure 2),

wherein when the destination name, corresponding to the receiving end to which the facsimile transmission is made is found amongst the destination names sorted in the storage section, said communication result notification is output in (d).

However Cairo does not teach (a) storing destination names of specific destinations in a storage section; and

- (c) searching the storage section for a destination name corresponding to the receiving end, identified in (b) and to which said facsimile transmission is being made; and
- (d) outputting a communication result notification indicative of a result of the facsimile transmission to the receiving end only when the corresponding destination name is found in the storage section,

wherein when the destination name, corresponding to the receiving end to which the facsimile transmission is made is found amongst the destination names sorted in the storage section, said communication result notification is output in (d).

Tanimoto does teach (a) storing destination names of specific destinations in a storage section (Page 7, paragraph 89); and

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(c) searching the storage section for a destination name corresponding to the receiving end, identified in (b) and to which said facsimile transmission is being made (Page 7, paragraph 89); and

(d) outputting a communication result notification indicative of a result of the facsimile transmission to the receiving end only when the corresponding destination name is found in the storage section (Page 7, paragraph 89).

wherein when the destination name, corresponding to the receiving end to which the facsimile transmission is made is found amongst the destination names sorted in the storage section, said communication result notification is output in (d) (Page 7, paragraph 89).

Cairo and Tanimoto are combinable because they deal with facsimile transmissions.

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teaching of Cairo with the teaching of Tanimoto for the purpose of providing the user with the ability to select the most appropriate transmission methods and operations (Tanimoto: Page 1, paragraph 11).

Regarding Claim 15, Cairo further teaches wherein the outputting outputs a communication result report for each facsimile transmission made to the receiving end having the corresponding destination name stored in the storage section (Column 8, lines 5-15).

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Regarding Claim 16, Cairo further teaches wherein the communication result report has contents and/or format set differently for each specific destination (Column 2, lines 50-54).

Regarding Claim 17, Cairo further teaches wherein the outputting displays or prints the communication result report (Column 8, lines 61-65).

Regarding Claim 18, Cairo in view of Tanimoto teaches wherein the outputting outputs a transmission end sound for each facsimile transmission made to the receiving end having the corresponding destination name stored in the storage section (Cairo: Column 8, lines 5-15, wherein since the user selects if they want a notification or not, since the notification could be a sound, they can select if they want the sound or not).

Regarding Claim 24, the computer readable storage medium which stores a program is treated as a method. Cairo does teach a receiving end identifying procedure causing the computer to identify a receiving end by analyzing terminal information received from the receiving end when making a facsimile transmission to the receiving end (Figure 1). a notifying procedure causing the computer to output a communication result notification indicative of a result of the facsimile transmission to the receiving end

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only when the specific destination identifying section finds the corresponding destination name in the storage section (Figure 1 and Figure 2),

wherein when the destination name corresponding to the receiving end to which the facsimile transmission is made is found amongst, the destination names stored in the storage section, said communication result notification is output in said notifying step.

However Cairo does not teach a specific destination name storage procedure causing the computer to store destination names of specific destinations in a storage section and a specific destination identifying procedure causing the computer to search from the storage section a destination name corresponding to the receiving end which is identified by the receiving end identifying section; and

a notifying procedure causing the computer to output a communication result notification indicative of a result of the facsimile transmission to the receiving end only when the specific destination identifying section finds the corresponding destination name in the storage section,

wherein when the destination name corresponding to the receiving end to which the facsimile transmission is made is found amongst, the destination names stored in the storage section, said communication result notification is output in said notifying step.

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Tanimoto does teach a specific destination name storage procedure causing the computer to store destination names of specific destinations in a storage section (Page 7, paragraph 89) and

a specific destination identifying procedure causing the computer to search from the storage section a destination name corresponding to the receiving end which is identified by the receiving end identifying section (Page 7, paragraph 89); and

a notifying procedure causing the computer to output a communication result notification indicative of a result of the facsimile transmission to the receiving end only when the specific destination identifying section finds the corresponding destination name in the storage section (Page 7, paragraph 89),

wherein when the destination name corresponding to the receiving end to which the facsimile transmission is made is found amongst, the destination names stored in the storage section, said communication result notification is output in said notifying step (Page 7, paragraph 89).

Cairo and Tanimoto are combinable because they deal with facsimile transmissions.

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teaching of Cairo with the teaching of Tanimoto for the purpose of providing the user with the ability to select the most appropriate transmission methods and operations (Tanimoto: Page 1, paragraph 11).

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Regarding Claim 25, Cairo further teaches wherein the notifying procedure causes the computer to output a communication result report for each facsimile transmission made to the receiving end having the corresponding destination name stored in the storage section (Column 8, lines 5-15).

Regarding Claim 26, Cairo further teaches wherein the communication result report has contents and/or format set differently for each specific destination (Column 2, lines 50-54).

Regarding Claim 27, Cairo further teaches wherein the notifying procedure causes the computer to display or print the communication result report (Column 8, lines 61-65).

Regarding Claim 28, Cairo in view of Tanimoto teaches wherein the notifying procedure causes the computer to output a transmission end sound for each facsimile transmission made to the receiving end having the corresponding destination name stored in the storage section (Cairo: Column 8, lines 5-15, wherein since the user selects if they want a notification or not, since the notification could be a sound, they can select if they want the sound or not).

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 Claims 6, 19, and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cairo (US 5.809.116) in view of Tanimoto (US 2003/0020960).

Regarding Claim 6, Cairo in view of Tanimoto does not teach wherein the transmission end sound is set differently for each specific destination.

Official notice is taken that if there is an end sound that is produced as a form of notification of delivery and that a notification of delivery can be different for every receiver, then the end sound can be different for every receiver.

Regarding Claim 19, Cairo in view of Tanimoto further teaches wherein the transmission end sound is set differently for each specific destination.

Official notice is taken that if there is an end sound that is produced as a form of notification of delivery and that a notification of delivery can be different for every receiver, then the end sound can be different for every receiver.

Regarding Claim 29, Cairo in view of Tanimoto does not teach wherein the transmission end sound is set differently for each specific destination.

Official notice is taken that if there is an end sound that is produced as a form of notification of delivery and that a notification of delivery can be different for every receiver, then the end sound can be different for every receiver.

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 Claims 7-10, 13, 20-23, and 30-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cairo (US 5,809,116) in view of Tanimoto (US 2003/0020960) further in view of Bloomfield (US 6,025,931).

Regarding Claims 7, 20, and 30, Cairo in view of Tanimoto does not teach wherein the notifying section, as described in claims 1, 14, and 24, prints a stamp mark on a scanned document for each facsimile transmission made to the receiving end having the corresponding destination name stored in the specific destination name storage section.

Bloomfield further teaches wherein the notifying section, as described in claims 1, 14, and 24, prints a stamp mark on a scanned document for each facsimile transmission made to the receiving end (Column 6, lines 57-62, where stamp mark can is anything printed on the scanned document, i.e. indicia of delivery) having the corresponding destination name stored in the specific destination name storage section (Column 6, lines 57-62, wherein by selecting to receive the confirmation, the receiver is stored in some form of storage).

Cairo in view of Tanimoto and Bloomfield are combinable because they deal with facsimile transmissions.

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teaching of Cairo in view of Tanimoto with the teaching of Bloomfield for the purpose of giving the sender an option to have a confirmation (Bloomfield: Column 6, lines 57-62).

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Regarding Claims 8, 21, and 31 Cairo in view of Tanimoto does not teach wherein the stamp mark, as disclosed in claims 7, 20, and 30, is set differently for each specific destination.

Bloomfield further teaches wherein the stamp mark, as disclosed in claims 7, 20, and 30, is set differently for each specific destination (Column 6, lines 57-62, where the address can be the stamp mark).

Cairo in view of Tanimoto and Bloomfield are combinable because they deal with facsimile transmissions.

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teaching of Cairo in view of Tanimoto with the teaching of Bloomfield for the purpose of giving the sender an option to have a confirmation (Bloomfield: Column 6, lines 57-62).

Regarding Claims 9, 22, and 32 Cairo in view of Tanimoto further teaches wherein the notifying section, as described in claims 1, 14, and 24, makes the communication report notification by one or an arbitrary combination of communication report notifications selected from a group consisting of outputting a communication result report, outputting a transmission end sound, and printing a stamp mark on a scanned document, for each facsimile transmission made to the receiving end having the corresponding destination name stored in the specific destination name storage

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section (Cairo: Column 8, lines 5-15, wherein since the user selects if they want a notification or not, since the notification could be a sound, they can select if they want the sound or not. Having the option to choose between a song and a display and none at all makes it inherit to have the choice of a stamp, a sound, or a result report).

Regarding Claims 10, 13, and 23, and 33 wherein the communication result report, the transmission end sound, and the stamp mark are set differently for each specific destination as described in claims 9, 12, 22, and 32, (see rejections for claim 3 for the communication result report, claim 6 for transmission end sound, and claim 8 for stamp mark as described in claims 9 and 12).

# Conclusion

 Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, THIS ACTION IS MADE FINAL. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nicholas C. Pachol whose telephone number is 571-270-3433. The examiner can normally be reached on M-Thr, 8:00 a.m.- 4:00 p.m. (EST), Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Twyler L. Haskins can be reached on 571-272-7406. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

N.P. 11/04/08

/Mark K Zimmerman/ Supervisory Patent Examiner, Art Unit 2625